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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,794

04/02/2007

Reiner Fischer

2400.0160000/SRL

3039

26111

7590

02/28/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

02/28/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/563,794	FISCHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ALTON N. PRYOR	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/8/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10,12,13 are rejected under 35 U.S.C. 112, first paragraph, because the specification while providing enablement for 1) the combination of 0.8 ppm compound I-4 and 0.0064 ppm compound II-4 and 2) the control of *Plutella* using 0.8 ppm of compound I-4 plus 0.0064 ppm of compound II-1, does not reasonably provide enablement for the control of *Plutella* using other amounts of compound I-4 and II-1. In addition, the specification does not provide enablement for any other claim combination of compound I and compound II. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims without an undue amount of experimentation.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: 1) scope or breadth of the claims; 2) nature of the invention; 3) relative level of skill possessed by one of ordinary skill in the art; 4) state of, or the amount of knowledge in, the prior art; 5) level or degree of predictability, or a lack thereof, in the art; 6) amount of guidance or direction provided by the inventor; 7) presence or absence of working examples; and 8)

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quantity of experimentation required to make and use the claimed invention based upon the content of the supporting disclosure. When the above factors are weighed, it is the Examiner's position that one skilled in the art could not practice the invention without undue experimentation.

1) Scope or breadth of the claims

The claims are broader in scope than the enabling disclosure. Applicant is purporting: enablement for all combinations of compound I and II. However, only control of *Plutella* using 0.8 ppm of compound I-4 plus 0.0064 ppm of compound II-1 is provided. Thus the combination comprising 0.8 ppm compound I-4 and 0.0064 ppm compound II-4 is enabled.

2) Nature of the invention

The nature of the invention is directed an invention comprising known compound I and known compound II. The compositions are used to control fungi, insects, etc.

4) State of, or the amount of knowledge in, the prior art

Fischer et al. (WO 0230199; 4/18/02 in view of English equivalent 20040102326; 5/27/04) and Sakata et al. (WO 02087334; 11/7/02 in view of English equivalent 2004/0077500; 4/22/04). Fischer et al. teach compound I-4 in paragraph 268. Fischer et al.s' compound I-4 is the same I-4 compound elected by Applicants. Fischer et al. teach that the compounds exhibit good insecticidal and acaricidal properties (abstract). Fischer et al. teach that formulations containing the I-4 compound can be made with the mixing of surfactants with the I-4 compound (paragraphs 326, 358) and optionally other

actives such as insecticides and fungicides (paragraph 364). The formulation is applied to the pests or habitat thereof (claim 7).

Sakata et al. teach compounds 130 and 133 in Table I of paragraph 26.

Compound 130 is the instant compound II-1. Sakata et al. teach that the compounds are useful as insecticidal and acaricidal (abstract). Sakata et al. teach that formulations containing the II-1 compound can be made with the mixing of compound II-1 with other actives such as insecticides and fungicides (paragraph 62).

It would have been obvious to modify the invention taught by Fischer et al. to include the compound 133 taught by Sakata et al. One would have been motivated to do this since both active compounds individually have insecticidal and acaricidal activity.

6) Amount of guidance or direction provided by the inventor

Applicant was required to provide in the specification additional guidance and direction with respect to how use the claimed subject matter in order for the application to be fully enabled. The specification provides results for 1) the combination of 0.8 ppm compound I-4 and 0.0064 ppm compound II-4 and 2) the control of Plutella using 0.8 ppm of compound I-4 plus 0.0064 ppm of compound II-1 (page 37 of specification)

7) Presence or absence of working examples

The specification fails to provide scientific data and working embodiments with respect to an invention control of Plutella using amounts of compound I-4 other than 0.8 ppm and compound II-1 other than 0.0064 ppm. In addition, the specification does not provide enablement for any other claim combination of compound I and compound II. No further evidence has been provided.

8) Quantity of experimentation required to make and use the claimed invention based upon the content of the supporting disclosure

One of ordinary skill in the art would have to conduct time-consuming and costly experimental methods to determine which combinations (including amounts) of compound I and compound II show unexpected activity (including which pests).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10,12,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al. (WO 0230199; 4/18/02 in view of English equivalent 20040102326; 5/27/04) and Sakata et al. (WO 02087334; 11/7/02 in view of English equivalent 2004/0077500; 4/22/04). Fischer et al. teach compound I-4 in paragraph 268. Fischer et al.'s compound I-4 is the same I-4 compound elected by Applicants. Fischer et al. teach that the compounds exhibit good insecticidal and acaricidal properties (abstract). Fischer et al. teach that formulations containing the I-4 compound can be made with the mixing of surfactants with the I-4 compound (paragraphs 326, 358) and optionally other actives such as insecticides and fungicides (paragraph 364). The formulation is applied to the pests or habitat thereof (claim 7). Fischer et al. do not teach compound II-1. However, Sakata et al. teach compounds 130 and 133 in Table I of paragraph 26. Compound 130 is the instant compound II-1. Sakata et al. teach that the compounds

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are useful as insecticidal and acaricidal (abstract). Sakata et al. teach that formulations containing the II-1 compound can be made with the mixing of compound II-1 with other actives such as insecticides and fungicides (paragraph 62). It would have been obvious to modify the invention taught by Fischer et al. to include the compound 133 taught by Sakata et al. One would have been motivated to do this since both active compounds individually have insecticidal and acaricidal activity.

### ***Election Status***

The elected invention comprising compound I-4 and compound II-1 broadly is not allowable. However, the invention comprising controlling *Plutella* with a composition comprising 0.8 ppm compound I-4 and 0.0064 ppm compound II-1 is allowable (unexpected data for this specific combination is provided in the specification at page 37).

### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616